

REMARKS

In the aforesaid Office Action, an election/restriction requirement under 35 USC § 121 was made, the claim for priority as a divisional application was objected to, the oath or declaration was objected to as being defective, the drawings were objected to under 37 CFR § 1.83(a), the specification and claims were objected to, claim 24 was rejected under 35 USC § 112, second paragraph, claims 22-25 were rejected under 35 USC § 102(e) as being anticipated by Wantink (US2003/003292A1), claims 22-25 were rejected under 35 USC § 102(b) as being anticipated by Fischell et al. (U.S. Patent No. 5,743,874), and claims 22-25 were rejected under the judicially created doctrine of double patenting. Claims 20-25 are pending, and claims 20 and 21 are withdrawn from consideration.

The Examiner required restriction to one of the following inventions, Group I, claims 20-21, drawn to a method of forming a distal tip; and Group II, claims 22-25, drawn to a balloon catheter. Applicants hereby affirm election of Group II, claim 22-25. The Examiner required election of a single disclosed species for prosecution on the merits from one of the following patentably distinct species, A/ figs. 1-5; B/ fig. 6; C/ fig. 7; and D/ fig. 8. Applicants hereby elect the species of Fig. 8, claims 22-25 readable thereon.

The Examiner objected to the drawings under 37 CFR § 1.87(a), stating that it appears that the balloon distal shaft section is only secured to the inner tubular member which is not the same as the catheter shaft since the equivalent of the catheter shaft would be the outer tubular member, so the “balloon on the distal catheter shaft section” or the

drawings or the feature(s) canceled from the claims. However, the Examiner's attention is directed to the first paragraph of the Detailed Description which discloses that "the catheter shaft 11 **comprises** an outer tubular member 18 having an inflation lumen 19, and an inner tubular member 21 having a guidewire receiving lumen 22 disposed within the inflation lumen 18", (emphasis added). Therefore, the specification discloses that the catheter shaft is made up of at least the inner and the outer tubular members 21,18. Therefore, the drawings illustrating the balloon proximal shaft section 26 disposed about the outer tubular member 18, and the balloon distal shaft section 27 disposed about the inner tubular member 21 do show the features of the invention referred to by the Examiner (namely a distal section of the balloon secured to the shaft 11, i.e., secured to the inner tubular member 21 of the shaft 11).

The Examiner objected to the specification, stating that it is unclear what the amendment filed on page 8 of the 11/19/01 preamendment is intending to further disclose. Applicants have amended the paragraph beginning on page 9, line 21 of the specification to delete the second occurrence of the range "0.05 to about 0.5 mm".

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter, stating that Applicants do not have support for "a sheath which is disposed about and secured to the proximal end of the tip member AND the distal end of the catheter shaft/inner tubular member". Applicants have amended claims 22 and 25, to obviate the objection. The Examiner also objected to the claim for priority as a divisional application and the oath/declaration. In view of the amendments

to the claims and to Fig. 8, Applicants request that the objections to the claim for priority and the oath/declaration be withdrawn.

The Examiner objected to claims 22-25, stating that it is unclear whether the “distal catheter shaft section” of claim 22, part b) is a section of the elongated catheter shaft or another section. Applicants have amended claim 22 to clarify that the “distal shaft section” refers to a section of the elongated catheter shaft. The Examiner further states that it is unclear whether the “catheter” of claim 22, part c) is the same as the elongated catheter or whether it is the balloon catheter of the device. Applicants have amended claim 22 to clarify that the “catheter” referred to the balloon catheter and not to the elongated catheter shaft. The Examiner further states that it is unclear whether the “catheter shaft” of claim 23 is the same as the elongated catheter shaft. Applicants have amended claim 23 to obviate the objection.

The Examiner rejected claim 24 under 35 USC § 112, second paragraph, stating that “inner tubular member” in line 2 lacks antecedent basis. Applicants have amended the claim to obviate the rejection.

The Examiner rejected claims 22-25 under 35 USC § 102(e) as being anticipated by Wantink. However, Wantink has a filing date of August 7, 2001 which is after the effective filing date of the instant application (December 21, 1999). Support for the embodiments set forth in currently amended claims 22 and 25 can be found in the second paragraph of the Detailed Description of the parent application as filed (09/471,053, filed December 21, 1999), disclosing that “a sheath (not shown) located distally adjacent to the distal end of the balloon distal shaft section 27 could be disposed about and secured to the

inner tubular member 21 or tip member 14 in place of the distal end of the balloon distal shaft section 27”.

The Examiner rejected claims 22-25 under 35 USC § 102(b) as being anticipated by Fischell et al., stating that Fischell et al. discloses a balloon catheter having a sheath 180 disposed and secured about the distal end of the inner tubular member 131 and the proximal end of the tubular tip member 110. However, Fischell et al. does not disclose or suggest a tip member having a proximal end spaced distally apart from the distal end of the elongated catheter shaft. Rather, in Fischell et al. the tip 110 is secured to the distal end of the shaft inner tubular member 130. Moreover, regarding claims 24 and 25, Fischell et al. does not disclose or suggest a balloon distal section secured to both the shaft and the tip.

The Examiner rejected claims 22-25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 7-14 of the parent application which issued as U.S. Patent No. 6,368,301. The Examiner states that the broader recitation of the balloon catheter in the pending application would be encompassed by the claims of the parent. However, the claims of the pending application require a sheath which is not required by the claims of the parent, and the Examiner has made an election requirement between the patentably distinct species of Figs. 1-5 (not having sheath 40) and Fig. 8 (having sheath 40).

Applicants wish to bring to the attention of the Patent Office the references listed on the attached PTO/SB/O8B, and request that they be considered by the Examiner. This

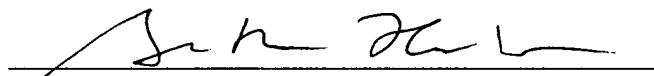
Information Disclosure Statement is being submitted pursuant to 37 CFR § 1.97(c)(2), and therefore the fee set forth in § 1.17(p) is due.

In light of the above amendments and remarks, applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

By:



Gunther O. Hanke

Registration No. 32,989

GOH/PMM/psm

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201